

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM R. DAVY

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Appeal No. 1997-3580  
Application 08/400,002

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ON BRIEF

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Before JERRY SMITH, BARRETT and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 5, 7, 12, 13 and 15-17, which constitute all the claims remaining in the application. An amendment after final rejection was filed on August 9, 1996 and was entered by the examiner.

The disclosed invention pertains to a computer system and method for moving data files from one location to another location while enabling the files to continue to be accessed by a user.

Representative claim 5 is reproduced as follows:

5. In a computer system comprising one or more disks, said system comprising means for defragmenting files by moving at least a portion of said files and by moving file positions on at least one of said disks, a method for moving at least a portion of an open file while said file is being accessed by a user, said method comprising the steps of:

determining a portion of said file to be moved from a first location to a second location;

copying said portion of said file to said second location while enabling said file to continue to be accessed by said user; and,

deallocating said first location after said copying step has been completed.

The examiner relies on the following references:

Walls	5,163,148	Nov. 10, 1992 (filed Aug. 11, 1989)
Johnson et al. (Johnson)	5,175,852	Dec. 29, 1992 (filed Oct. 04, 1989)
Sathi	5,212,786	May 18, 1993 (filed Apr. 01, 1991)

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Claims 5, 7, 12, 13 and 15-17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Walls in view of Sathi with respect to claims 5, 7 and 17, and the examiner adds Johnson to this combination with respect to claims 12, 13, 15 and 16.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record

before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 5, 7, 12, 13 and 15-17. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,

664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 5, 7 and 17 based on the teachings of Walls and Sathi. These claims stand

or fall together [brief, page 6], and we will consider independent claim 5 as the representative claim for this rejection. The examiner's rejection basically asserts that Walls teaches all the features of claim 5 except for the deallocation of the first memory location. The examiner cites Sathi as teaching the deallocation of a first memory location after moving a file from the first memory location to a second memory location. The examiner concludes that it would have been obvious to the artisan to deallocate the first memory location in the system of Walls to free that memory for storing new files as suggested by Sathi [answer, pages 3-4].

Appellant argues that neither Walls nor Sathi is directed to moving open files. Appellant also argues that Sathi is non-analogous art because it does not relate to the movement of open files. Finally, appellant argues that there would be no motivation to modify the Walls system with the deallocation taught by Sathi because such deallocation would destroy the very purpose of Walls which is to retain a backup as a safeguard against information loss [brief, pages 6-11].

We consider appellant's last argument as dispositive

of this appeal. Specifically, appellant argues that the desired result of the system disclosed by Walls is to have two copies of a file as a safeguard. Performing the deallocation step of Sathi in the system of Walls would result in the elimination of one of the files in Walls which would defeat the very purpose of the Walls backup. The examiner responds that "a backup system 'by definition' is not limited to merely copying a file from a first local location to a second backup location (i.e.; wherein both

copies must continue to exist, as asserted by Appellant), but also allows for subsequently deleting the original local copy of the file in those instances when local memory is becoming full (i.e.; 'archiving' systems are a type of 'backup' system wherein both copies of a file do not necessarily continue to exist, based upon memory space restrictions" [answer, page 5]. The examiner also notes that "Appellant's assertion that a backup-type system must necessarily maintain both copies of a copied file is in error" [id., page 6].

We do not understand the examiner's supposed

"definition" of a "backup system," and we do not find any evidence on this record to support the examiner's assertions as to what is apparently implied by a backup system. On the other hand, we completely agree with appellant that the deallocation taught by Sathi would destroy the purpose of Walls which is to retain a backup copy of a file in addition to the working file. Despite the relative simplicity of the claimed invention and the separate teachings of the claimed steps in the collective teachings of the references, we are compelled to agree with appellant that there is simply no rational basis for the artisan to modify the backup system of Walls with the deallocation as recited in claim 5. The only basis for making the modification proposed by the examiner is to improperly reconstruct appellant's invention in hindsight.

Since we find that there is no motivation for combining the teachings of Walls and Sathi in the manner proposed by the examiner, we do not sustain the rejection of claims 5, 7 and 17 as proposed by the examiner.

We now consider the rejection of claims 12, 13, 15 and 16 based on the teachings of Walls, Sathi and Johnson. As noted above, the teachings of Walls and Sathi are not properly



combined. Since Johnson does not overcome the deficiencies of this improper combination of teachings, we also do not sustain the rejection of these claims.

Although we have determined that the examiner's proposed combination of Walls and Sathi is improper, we also think the invention of claim 5 is much broader than what the examiner is trying to find. The essence of claim 5 is that a portion of a file is copied from a first location to a second location while enabling the file to be accessed by a user followed by a deallocation of the first location after the copying is complete. The copying step is met by a typical COPY command of an operating system as opposed to a similar MOVE command. That is, it is understood that a file may be accessed by a user while it is

being copied from one location to another. Claim 5 places no limitation on the deallocation step except that it occurs after the copying is complete. Thus, the deallocation could take place immediately after copying, a minute after, an hour after, a week after and so forth. It appears to us that claim 5 presently reads on any system in which a computer user has

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copied a file from one location to another and then deleted the original file (or deallocated the first location) at some later date.

Although we are of the view that claim 5 includes within its scope subject matter which is probably not patentable to appellant (or anyone else), we decline to make a rejection under 37 CFR § 1.196(b) in this decision because of the lack of a factual record to support this view. Any appropriate rejection and the presentation of arguments and/or evidence should be developed by appellant and the examiner and not by us. We invite the examiner to consider whether the broadest reasonable interpretation of claim 5 (and other claims) covers an invention which is rendered unpatentable by the conventional copying step of a file followed at any time by the conventional deleting step of the file.

In summary, we have not sustained the rejection of the claims under 35 U.S.C. § 103 based on the references cited by the examiner and the rationale proffered by the examiner for combining the teachings of these references. Therefore, the

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examiner's rejection of claims 5, 7, 12, 13 and 15-17 is  
reversed.

REVERSED

	JERRY SMITH	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	LEE E. BARRETT	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	ANITA PELLMAN GROSS	)	
	Administrative Patent Judge	)	

JS/ki

James G. Gatto  
Baker & Botts  
The Warner  
1299 Pennsylvania Avenue, NW

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Washington, DC 20004-2400